

## **REMARKS**

In the outstanding office action, claims 1 and 3-44 were presented for examination. Claims 1 and 3-44 were rejected. Specifically, Claims 1 and 3-35 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Mitra et al. (US Patent No. 6,673,761). Claims 1 and 3-35 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Ouellette et al. (US 2004/0244132). Claims 36-44 were rejected under 35 U.S.C. §103(a) as unpatentable over Mitra et al. (US Patent No. 6,673,761). Claims 36-44 were rejected under 35 U.S.C. §103(a) as unpatentable over Ouellette et al. (US 2004/0244132). Claims 1 and 3-44 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Shannon (US 20043/0168642).

Claims 1, 8, 23, 29 and 36 have been amended, no claims have been added and no claims have been canceled leaving claims 1 and 3-44 for consideration upon entry of the present amendment. Amended claims 1, 8, 23, 29 and 36 add no new matter.

Support for the claim amendments to claims 1, 23, 29 and 36 are found throughout the specification, and at least at page 4, paragraph [0019] to page 5 paragraph 21; page 6, paragraph 27; and particularly, Example 1 found on page 8, paragraph 33 of the specification. Claim 8 has been amended for clarity.

Applicants respectfully request entry of the amendments.

- 1. Rejection of claims 1 and 3-35 under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitra et al., U.S. 6,673,761, hereafter “Mitra” or “761.”**

Claims 1 and 3-35 have been rejected as being anticipated by, or, in the alternative, obvious over Mitra et al. Applicants respectfully traverse these rejections.

As amended, claim 1 recites a cleaning formulation which comprises surfactant in an amount ranging between more than 5 wt.% and about 10 wt.% of the cleaning formulation. As amended claim 23 recites a cleaning formulation which comprises

surfactant selected from the group comprising anionic surfactant and combinations of at least one anionic surfactant and at least one ionic surfactant, wherein the total amount of surfactant is an amount ranging between more than 5 wt.% and 10 wt.% of the cleaning formulation. As amended, claim 29 depends from claim 23 and recites all of the limitations of claim 23 and further recites a cleaning formulation wherein the at least one anionic surfactant present in an amount ranging between more than 0 wt.% to about 5 wt.% of the cleaning formulation. As amended, claims 1, 23 and 29 recite surfactant in an amount ranging between more than 5 wt.% and about 10 wt.% of the cleaning formulation which is not taught or claimed in Mitra.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Mitra fails to meet this standard. Nothing in Mitra discloses or claims a composition comprising surfactant in an amount ranging between more than 5 wt.% and about 10 wt.%. Thus Mitra fails to teach all of the elements of Applicants' amended independent claims 1 and 23. Therefore, Mitra cannot anticipate the present claims 1 and 3-35.

Claims 1-35 were also rejected in the alternative as being obvious over Mitra et al. Applicants respectfully traverse the rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir.1996).

Mitra fails to satisfy this standard. First, Mitra fails to disclose all of the elements of the claimed invention. As discussed herein, nothing in Mitra discloses or claims a composition comprising surfactant in an amount ranging between more than 5 wt.% and about 10 wt.%. Secondly, Mitra provides no motivation for one skilled in the art to modify the teachings of Mitra to achieve the claimed invention. Mitra is directed to a disinfecting cleaning wipe. All of the claims of Mitra require a cationic biocide release agent to increase the amount of biocide released from the cleaning wipe onto the surface to be disinfected. (Mitra, col. 5, line 67 to col. 6 line 32; Claims) One skilled in the art could not achieve the claimed invention and would have no motivation to modify the teachings of Mitra with any reasonable expectation of success of achieving the claimed invention. Therefore, a *prima facie* case of obviousness cannot be established and the present claims 1 and 3-35 are non-obvious over Mitra et al. Applicants respectfully request removal of the rejection of claims 1 and 3-35.

**2. Rejection of claims 1 and 3-35 under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oulette et al., U.S. 2004/0244132, hereafter "Oulette" or "132."**

Claims 1 and 3-35 stand rejected as anticipated by, or, in the alternative as obvious over Ouellette. Applicants traverse these rejections.

Claims 1 and 23 have been amended to recite the limitation of water is present in an amount ranging between 50 wt.% and about 99 wt.% of the cleaning formulation, which applicant respectfully submits is clearly not shown, disclosed or taught by the Ouelette et al. reference.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Oulette fails to meet this standard. Specifically, Oulette fails to describe the cleaning formulation of Applicants' amended claims 1 and 23. The presently claimed

formulation is directed to a cleaning formulation comprising a cleaning composition, wherein water is present in an amount ranging between 50 wt.% and about 99 wt.% of the cleaning formulation.

In contrast, Oulette teaches that “water is preferably present at a level of less than 50%, more preferably less than about 10%, and most preferably, less than about 5%.” (‘132, page 12, paragraph [0156]). Thus, Oulette cannot be said to be anticipatory as it fails to disclose all the material elements of Applicants’ amended claims 1 and 23.

Claims 1 and 3-35 were also rejected in the alternative as being obvious over Oulette. Applicants respectfully traverse the rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir.1996).

Oulette fails to meet the standard for establishing obviousness. As discussed herein, Oulette does not disclose all of the elements of the present invention. Moreover, nothing in Oulette provides motivation to one skilled in the art to modify the teachings of Oulette to achieve the claimed invention. As amended, the present claims do not overlap or even come close to the teachings of Oulette. Moreover, the teachings of Oulette actually teach away from the present claims which recite water in an amount ranging between more than 50 wt. % and about 99 wt.% of the cleaning formulation. In contrast, as discussed herein, Oulette discloses water present less than 50 wt.%. Therefore, one skilled in the art would not be motivated to achieve the claimed cleaning formulation

comprising water in an amount ranging between more than 50 % wt. % and about 99 wt.%, when the teachings of Oulette specifically indicate the otherwise.

Therefore, Applicants believe that a *prima facie* case has not been established against the claims and respectfully requests removal of the rejection of claims 1 and 3-35.

**3. Rejection of claims 36-44 under 35 U.S.C. 103(a) as obvious over Mitra et al., U.S. 6,673,761, hereafter "Mitra" or "761."**

Claims 36-44 stand rejected as being obvious over Mitra. Applicants respectfully traverse the rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir.1996).

Claim 36 has been amended to recite sodium lauryl sulfate present in an amount ranging between more than 0 wt.% to about 10 wt. % of the cleaning formulation and an ethoxylated alcohol nonionic surfactant present in an amount ranging between more than 0 wt. % to about 5 wt. % of the cleaning formulation. Nothing in Mitra discloses or claims this novel combination in the recited amounts to achieve the claimed formulation. Absent also is any suggestion to make the claimed formulation. One skilled in the art would not be motivated to modify the disinfectant wipe disclosed in Mitra to include the combined requisite amounts of sodium lauryl sulfate and ethoxylated alcohol nonionic surfactant with any reasonable expectation of success of achieving the claimed invention.

Moreover, Applicants believe the Examiner has used an improper hindsight in arriving at the rejections. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See In re Dembiczak*, 175 F.3d. 994 (Fed. Cir. 1999) and cases cited therein.

In this case, the Examiner has plucked certain teachings from Mitra and states that because he has found obvious limitations of the claims that the claims should be rejected. The Examiner then uses Applicants Specification to figure out how to combine the limitations to reach the claimed invention. One skilled in the art, much less one having only routine skill in the art, would not have known or been motivated to modify Mitra to reach the claimed invention. Instead, the Examiner has used improper hindsight and has used Applicant's disclosure to provide the necessary teaching. It is improper for the Examiner to use Applicant's Specification as a road map to reject the claims. Thus, the claims are non-obvious over Mitra. Applicants respectfully request removal of the rejection.

**4. Rejection of claims 36-44 under 35 U.S.C. 103(a) as obvious over Oulette et al., U.S. 2004/0244132, hereafter "Oulette" or "132."**

Claims 36-44 stand rejected as being obvious over Oulette. Applicants respectfully traverse the rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165

U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir.1996).

The foregoing remarks for section 2 are incorporated herein by reference. As discussed therein, Oulette fails to teach or disclose a cleaning formulation comprising a cleaning composition, wherein water is present in an amount ranging between 50 wt.% and about 99 wt.% of the cleaning formulation. Moreover, Oulette provides no motivation to one skilled in the art to modify Oulette with any reasonable expectation of success of achieving the claimed formulation. As a result it is respectfully submitted that Oulette fails to establish a *prima facie* case of obviousness with respect to amended independent claim 36. Therefore, claims 36-44 are non-obvious over Oulette, and Applicants respectfully request removal of the rejection.

**5. Rejection of claims 1 and 3-44 under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shannon, U.S. 2003/0168642, hereafter “Shannon” or “’642.”**

Claims 1 and 3-34 have been rejected as being anticipated by, or, in the alternative, obvious over Shannon Applicants respectfully traverse these rejections.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). While the prior art reference need not use identical terminology, the reference must “sufficiently describe the claimed invention to have placed the public in possession of it.” *Minnesota Mining & Mfg. Co. v Johnson & Johnson Orthopedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir.1992).

The presently claimed formulation is directed to a cleaning formulation comprising a cleaning composition to provide cleaning efficacy and includes a brake dust barrier composition in sufficient amount to provide brake dust efficacy. As amended, claim 1 recites a cleaning formulation which comprises surfactant in an amount ranging

between more than 5 wt.% and about 10 wt.% of the cleaning formulation. As amended claim 23 recites a cleaning formulation which comprises surfactant selected from the group comprising anionic surfactant and combinations of at least one anionic surfactant and at least one nonionic surfactant, wherein the total amount of surfactant is an amount ranging between more than 5 wt.% and 10 wt.% of the cleaning formulation. As amended, claim 29 depends from claim 23 and recites all of the limitations of claim 23 and further recites a cleaning formulation wherein the at least one anionic surfactant present in an amount ranging between more than 0 wt.% to about 5 wt.% of the cleaning formulation. As amended, claims 1, 23 and 29 recite surfactant in an amount ranging between more than 5 wt.% and about 10 wt.% of the cleaning formulation which is not taught or claimed in Shannon.

Shannon is directed to dust repellant film-forming compositions. The compositions disclosed in Shannon comprise wetting agents including surfactants for lowering surface tension. (Shannon, page 1, paragraph [0009] – [0012], [0027]) Claim 36 has been amended to recite sodium lauryl sulfate present in an amount ranging between more than 0 wt. % to about 10 wt. % of the cleaning formulation and an ethoxylated alcohol nonionic surfactant present in an amount ranging between more than 0 wt. % to about 5 wt. % of the cleaning formulation. Nothing in Shannon discloses the surfactant in an amount ranging between more than 5 wt.% and about 10 wt.% of the cleaning formulation. Moreover, Shannon is silent as to nonionic surfactat. As such, Shannon does not disclose all the elements of the claimed invention, and claims 1 and 3-35 are not anticipated by Shannon. Furthermore, nothing in Shannon discloses or claims this unique combination of elements including anionic surfactant, nonionic surfactant and combinations thereof in the recited amounts to achieve the claimed. As such, claims 36-44 are not anticipated by Shannon.

Removal of the rejection of claims 1 and 3-44 is respectfully requested.

Claims 1 and 3-34 were also rejected in the alterative as being obvious over Shannon. Applicants respectfully traverse the rejection.



For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Shannon is directed to compositions having anti-static properties which lower surface tension due to wetting agents (B) and (D) (Shannon, paragraphs [0010]-[0012]). As further disclosed,

“The emulsifier is selected to maintain the surface tension of the aqueous emulsion below about 25 milli-newtons per meter, otherwise the resulting polymeric film will attract, rather than repel, dust, soil and grime. For example, surfactants that have large hydrophobic, fatty moiety, such as stearic acid or stearyl alcohol derived surfactant emulsifiers actually increase dust and soil loading on the surfaces of the polymeric films to which they have been added.”

(Shannon, paragraph [0034])

As taught in Shannon, wetting agents (B) and (D) would not function nor have the same purpose as the surfactant disclosed in the present application and wetting agents (B) and (D) operate on a completely different principle than the instant claims. In this manner, not only are wetting agents (B) and (D) distinguishable from the present surfactants, Shannon actually teaches away from using the surfactant(s) of the present claims, both in composition and functionality. Based on the teachings of Shannon, one skilled in the art would not be motivated to use the surfactant to achieve a brake dust barrier as disclosed and claimed in the present application.

As discussed herein, Shannon does not disclose all of the claim elements. And thus fails to meet the standard for establishing a *prima facie* case of obviousness. In

addition, Shannon provides no suggestion or motivation to one skilled in the art to modify the teachings of Shannon to achieve the claimed invention, and actually teaches away from using the presently disclosed surfactant to achieve brake dust efficacy.

Therefore, Applicants believe that a *prima facie* case of obviousness has not, and cannot be, established and respectfully request removal of the rejection of claim 1 and 3-44.

### CONCLUSION

In view of the above amendments and the discussion relating thereto, it is respectfully submitted that the present application is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130, maintained by the applicant's attorney.

Respectfully submitted,

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